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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,797

09/29/2006

Barry W. Townsend

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

05/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,797	Applicant(s) TOWNSEND ET AL.	
	Examiner JAVIER G. BLANCO	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 12, 24, 30, 32, 35, 41, 43 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-23, 25-29, 3, 33, 34, 36-40, 42, 44, 45, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s)

3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date: 9/29/2006; 3/28/2007; 5/5/2008; 5/8/2009; 10/9/2009; 2/17/2010; and 3/15/2010.

DETAILED ACTION

Election/Restrictions

1. Applicants' election of the Prosthesis: Species D (embodied in Figure 32) in the reply filed on February 16, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 12, 24, 30, 35, 41, and 46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 16, 2010. Further, each of dependent claims 32 and 43 are drawn to a nonelected species. Therefore, claims 32 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

4. The claims are objected to because of the following informality: please substitute each instance of "the device" with --the posterior calf device--. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11, 13-23, 25-29, 31-34, 36-40, 42-45, 47, and 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. **7,374,578** and claims 1-20 of U.S. Patent No. **7,578,852**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-11, 13-23, 25-29, 31-34, 36-40, 42-45, 47, and 48 of the application and claims 1-23 of U.S. Patent No. **7,374,578** and claims 1-20 of U.S. Patent No. **7,578,852** lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-23 of U.S. Patent No. **7,374,578** and claims 1-20 of U.S. Patent No. **7,578,852** is in effect a "species" of the "generic" invention of claims 1-11, 13-23, 25-29, 31-34, 36-40, 42-45, 47, and 48. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir.

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1993). Since claims 1-11, 13-23, 25-29, 31-34, 36-40, 42-45, 47, and 48 of the application are anticipated by claims 1-23 of U.S. Patent No. **7,374,578** and claims 1-20 of U.S. Patent No. **7,578,852**, it is not patentably distinct from claims 1-23 of U.S. Patent No. **7,374,578** and claims 1-20 of U.S. Patent No. **7,578,852**.

7. Claims 1-11, 13-23, 25-29, 31-34, 36-40, 42-45, 47, and 48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (i) Pending claims of copending Application No. **11/234,159**;
- (ii) Pending claims of copending Application No. **11/411,133**;
- (iii) Pending claims of copending Application No. **11/643,676**;
- (iv) Pending claims of copending Application No. **11/643,677**; and
- (v) Pending claims of copending Application No. **10/594,798**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the above-indicated applications claim an ankle and a shank connected to a foot and comprising a resilient member having a lower end reversely curved (or in the form of a spiral). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10, 11, 13-20, 22, 23, 25-29, 31, 33, 34, 36-39, 42, 44, 45, 47, and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Celebi** (US 6,402,790; cited in Applicants' IDS).

Referring to Figures 1, 2, and 11, **Celebi** discloses a prosthetic foot comprising:

- (i) A longitudinally extending foot keel (40) having forefoot (42), an upwardly arched midfoot (51/52), and hindfoot (43) portions;
- (ii) A resilient, upstanding calf shank (Figure 2: upstanding shank 23) having a reversely curved lower end (spiral 24) connected to the foot keel and extending upwardly therefrom to a middle portion of the shank by way of an anterior facing convexly curved surface (Figures 1 and 2: any of ribs 81, or general outline of shank 23) extending upwardly in a substantially curvilinear manner above the ankle joint area, the shank having an upper end *for connection* with a supporting structure on a person's leg stump; and
- (iii) A posterior calf device on the prosthesis capable of storing energy during force loading of the prosthesis and returning the stored energy during force unloading to increase the kinetic power generated for propulsive force by the prosthesis in gait, wherein said posterior calf device includes at least one elongated member (one of ribs 81) extending between the upper portion of the shank and a lower portion of the prosthesis, and at least one spring (26 and/or 60) which is resiliently biased by the at least one elongated member in response to anterior movement of the upper end of the shank for storing energy.

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Wherein the calf shank is secured to the foot by way of a coupling element (41) which is monolithically formed with the forefoot portion (42) of the foot and which houses (see anterior facing concavity 44/46) the reversely curved lower end of the calf shank. Notice no particular structure has been claimed for the “coupling element”. As clearly shown in the figures, the coupling element extends posteriorly from the forefoot portion as a cantilever over the midfoot portion and part of the hindfoot portion of the foot. Regarding claim 8, among others, the “stop” is either one of 61, 71, and/or anterior groove of 24.

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **Celebi**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

10. Claims 1-10, 13-22, 25-29, 31, 33, 36-40, 42, 44, 47, and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Phillips** (US 5,376,141; cited in Applicants’ IDS). Referring to Figures 3-9, **Phillips** discloses a prosthetic foot comprising:

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- (i) A longitudinally extending foot keel having forefoot (12), an upwardly arched midfoot (32), and hindfoot (14) portions;
- (ii) A resilient, upstanding calf shank (Figures 5 and 9: upstanding shank 50) having a reversely curved lower end (spiral represented by sections 68 and 66) connected to the foot keel and extending upwardly therefrom to a middle portion of the shank by way of an anterior facing convexly curved surface (clearly shown in Figures 5 and 9) extending upwardly in a substantially curvilinear manner above the ankle joint area, the shank having an upper end *for connection* with a supporting structure on a person's leg stump; and
- (iii) A posterior calf device (Figures 4, 5, and 9: any of the posterior layers forming the shank and/or "coupling element"; Figure 6: 70, 74) on the prosthesis capable of storing energy during force loading of the prosthesis and returning the stored energy during force unloading to increase the kinetic power generated for propulsive force by the prosthesis in gait. Notice no structure has been claimed for the "posterior calf device".

Wherein the calf shank is secured to the foot by way of a coupling element (22/24) which is monolithically formed with the forefoot portion (12) of the foot and which houses (see anterior facing concavity 22/24) the reversely curved lower end of the calf shank. Notice no particular structure has been claimed for the "coupling element". As clearly shown in the figures, the coupling element extends posteriorly from the forefoot portion as a cantilever over the midfoot portion and part of the hindfoot portion of the foot. Regarding claim 8, among others, the "stop" is 76. Regarding claim 9, among others, the prosthetic foot further comprises a cosmetic covering (Figure 5) in the shape of a human foot and lower leg, the cosmetic covering being

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located over the foot, ankle and at least the lower end of the shank with the shank extending upward from the ankle within the lower leg covering.

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **Phillips**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

11. Claims 1-8, 10, 11, 13-20, 22, 23, 25-29, 31, 33, 34, 36-39, 42, 44, 45, 47, and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Pitkin** (US 5,376,139; cited in Applicants’ IDS).

Referring to Figures 1-3, Pitkin discloses a prosthetic foot comprising:

- (i) A longitudinally extending foot keel (3) having forefoot (front 1/3 of keel 3), an upwardly arched midfoot (middle 1/3 of keel 3), and hindfoot (rear 1/3 of keel 3) portions;
- (ii) A resilient, upstanding calf shank (1) having a lower end (bottom half) connected to the foot keel and an upper end (upper half, which includes loop 6) to connect with a supporting structure

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on an amputee's leg, the upper end being *movable* longitudinally of the foot keel in response to force loading and unloading of the calf shank during use of the prosthetic foot. The “anterior facing convexly curved portion” is loop 6, and the “reversely curved lower end in the form of a spiral” is spiral formed by 7 + 2;

(iii) A posterior calf device including an elongated member (any of curvilinear springs 4) *to store energy during force loading of the prosthesis and return the stored energy during force unloading (e.g., controls anterior movement, and assists posterior movement) to increase the kinetic power generated for propulsive force by the prosthesis in gait.* Notice no structure has been claimed for the “posterior calf device”. The “at least one spring” is one of curvilinear springs 4.

Wherein the calf shank is secured to the foot by way of a coupling element (upper arch of keel 40) which is monolithically formed with the forefoot portion (front 1/3 of keel 3) of the foot and which houses (see anterior facing concavity) the reversely curved lower end of the calf shank. Notice no particular structure has been claimed for the “coupling element”. As clearly shown in the figures, the coupling element extends posteriorly from the forefoot portion as a cantilever over the midfoot portion and part of the hindfoot portion of the foot.

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; ; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **Pitkin**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re*

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Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 9, 21, 29, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Celebi** (US 6,402,790; cited in Applicants’ IDS).

Celebi discloses the invention as claimed except for particularly disclosing using a cosmetic covering. However, this is already well known in the art. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a cosmetic covering with the prosthetic foot of Celebi for the well known advantages of protecting (e.g., from dust, oil, water, etc.) the prosthetic foot and also to provide a cosmetic appearance to the prosthetic foot.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on **(571)272-4749**. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Javier G. Blanco/

Examiner, Art Unit 3774

/David H Willse/

Primary Examiner, Art Unit 3738